

Remarks/Arguments

In this Amendment, Applicants amend claims 6, 9, 16, 19, 24, 27, 35, 37, 44, 46, 51, and 54. No new matter has been added. Claims 1-5 had been previously cancelled. Therefore, it is respectfully submitted that claims 6-61 are currently pending in this application. Reconsideration of this application is respectfully requested in view of the following remarks.

Double Patenting

On page 2 of the Office Action, the Examiner rejected claims 6-8, 10, 11, 13-18, 20, 21, 23-26, 28, 29, 31-34, 51-53, 55, 56, and 58-61 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 4, 5, 8, and 14 of issued U.S. Patent No. 6,735,778. In order to expedite allowance of the present application, Applicant hereby files a terminal disclaimer under 37 C.F.R. § 1.321 for the pending claims 6-61.

35 U.S.C. § 102(e) Rejection – claims 6-9, 16-19, and 24-50.

On page 5 of the Office Action, the Examiner rejected claims 6-9, 16-19, and 24-50 under 35 U.S.C. § 102 (e) as being anticipated by Smolen (U.S. Patent No 5,915,243) (“Smolen”). Applicants traverse this rejection because Smolen fails to disclose each and every claim feature.

For example, amended claim 6 includes a combination of claim features including, *inter alia*, “generating a home shopping program list that identifies a **plurality of motion picture home shopping programs** related to the personalized data . . . **the transmitted home shopping program including one or more instructions for ordering an item displayed for sale in the**

home shopping program.” (Emphasis added.) Smolen fails to disclose at least these claim features.

In the Office Action, the Examiner maintained that Smolen discloses an apparatus for delivering promotions such as advertisements or commercials on television and for transmitting the promotions to television. See Office Action, pages 5 and 6 (citing Smolen, column 7 lines 58-65 and column 6 lines 14-18). The Examiner asserted that this disclosure of Smolen constitutes “transmitting a motion picture home shopping program identified in the home shopping program list to the viewer.” See Office Action, page 6. Applicants disagree.

A thorough review of Smolen reveals that Smolen fails to disclose “generating a home shopping program list that identifies a plurality of motion picture home shopping programs related to the personalized data . . . the transmitted home shopping program including one or more instructions for ordering an item displayed for sale in the home shopping program,” as featured in amended claim 6. Specifically, Smolen discloses “targeting promotions and coupons by filtering the information for selected marketing criteria.” See Smolen column 3, lines 2-4. Smolen also discloses that “promotions may be immediately offered to the person or household, or may be offered to the person or household at a later time by transmitting promotion information to a printing facility.” See Smolen column 3, lines 5-10.

Smolen also discloses that promotions may be displayed sequentially on television or the user may be offered all of the promotions at once. See Smolen column 6, lines 35-38 and lines 52-55. However, none of these portions cited from Smolen, and indeed no other portion of Smolen discloses “generating a home shopping program list that identifies a **plurality of motion picture home shopping programs** related to the personalized data,” (Emphasis added) as

featured in claim 6. Applicants respectfully submit that a promotion displayed on television does not constitute a “motion picture home shopping program”, as featured in claim 6. Furthermore, no portion of Smolen discloses “the transmitted home shopping program including one or more instructions for ordering an item displayed for sale in the home shopping program,” as also featured in amended claim 6.

Because Smolen fails to disclose each and every claim feature, the Section 102 rejection of claim 6 should be withdrawn. Independent claims 16, 24, 35, and 44 while different in scope, include claim features similar to those in claim 6 and, therefore, are allowable over Smolen for at least the reasons discussed above. For example, amended claim 44 is also a method claim but with differing scope than claim 6 and also including “transmitting a **motion picture home shopping program** related to the personalized data to the viewer for immediate available viewing independent of a broadcast schedule, **the transmitted home shopping program including one or more instructions for ordering an item displayed for sale in the home shopping program.** (Emphasis added.) As discussed above, Smolen fails to disclose at least these claim elements.

Dependent claims 7-9, 17-19, 25-34, 36-43, and 45-50 ultimately depend from one of claims 6, 16, 24, 35, and 44 and, therefore, are allowable for at least the reasons discussed above and in view of their additional recitations of novelty.

35 U.S.C. § 103 Rejections – claims 10-12 and 20-22

On page 15 of the Office Action, claims 10-12 and 20-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Smolen in view of Robertson (Patent No 6,609, 106)

(“Robertson”). Applicants traverse this rejection because the combination of Smolen and Robertson fails to disclose each and every claim feature. Claim 10, 12, and 20-22 ultimately depend from one of allowable claims 6 and 16 and also include additional recitations of novelty. Furthermore, Robertson, relied upon for its alleged disclosure of a gift registry for all occasions (see Office Action, page 16 (citing Robertson column 3 lines 19-20)) fails to remedy the deficiency of Smolen as discussed above with respect to claims 6 and 16. Therefore, for at least the reason that the combination of Robertson and Smolen fails to disclose each and every claim feature, the Section 103 rejection of claims 10-12 and 20-22 should be withdrawn.

35 U.S.C. § 103 Rejections – claims 13-15, 23, and 51-61

On page 19 of the Office Action, claims 13-15, 23, and 51-61 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Smolen in view of Herz (U.S. Patent No: 6,088,722) (“Herz”). Applicants traverse this rejection because the combination of Smolen and Herz fails to disclose each and every claim feature. Claims 13-15 and 23 ultimately depend from one of allowable claims 6 and 16 and also include additional recitations of novelty. Furthermore, Herz fails to disclose some claim features that, as admitted by the Examiner, are not disclosed by Smolen (see Office Action pages 20-21). For example, claim 14 depends from claim 6 and further includes “**receiving a modified version** of the home shopping program list **from the viewer.**” (Emphasis added.) In the Office Action, the Examiner maintained that though Smolen fails to disclose this claim feature, Herz “discloses that one can modify the algorithm to take into account other known determinants related to customer behavior, wherein such algorithm is used to determine the broadcasted schedule based on the customer’s profile (see Office Action pages

20-21 (citing Herz, column 34, lines 58-59; and column 23, lines 40-46.)) Applicants respectfully submit that the Examiner has misinterpreted Herz. Indeed, contrary to the Examiner's assertion, Herz fails to disclose "receiving a modified version of the home shopping program list from the viewer."

Herz discloses "[a] system and method for scheduling the receipt of desired movies and other forms of data from a network." See Herz, Abstract. To this end, Herz discloses "an algorithm which uses customer profiles and content profiles for scheduling the broadcast of movies and other shows over a video distribution network." See Herz, column 23 lines 40-43. Herz further discloses that scheduling variations may be made by "[removing] recently shown movies from the list of movies available to broadcast [or by removing] recently shown movies from the list of movies available to broadcast when their popularity (number of customers per broadcast) drops below a threshold." See Herz, column 28 lines 24-28. As a variation to the algorithm, Herz discloses that "one can modify the algorithm to take into account other known determinants of customer behavior." See Herz, column 34, lines 58-59. Thus, Herz apparently discloses that a **broadcast system** can vary broadcast schedules based on customer preferences. This does not constitute "**receiving a modified version** of the home shopping program list **from the viewer**," as featured in claim 14. Thus, for at least the reason that the combination of Smolen and Herz fails to disclose each and every claim feature, the Section 103 rejection of claims 13-15 and 23 should be withdrawn.

Independent claim 51 is a system claim that although different in scope, includes claim features similar to claims 6, 16, 24, 35, and 44. Therefore, similar to claims 6, 16, 24, 35, and 44, independent claim 51 includes features that are not disclosed by Smolen. For example,

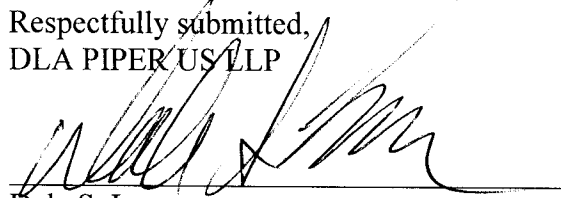
amended claim 51 includes a combination of claim features including, *inter alia*, “one or more processors in communication with the one or more memories, wherein the one or more processors are operative to . . . transmit a home shopping program identified in the home shopping program list to the viewer, **the transmitted home shopping program including one or more instructions for ordering an item displayed for sale in the home shopping program.**” (Emphasis added.) As discussed above, Smolen fails to disclose at least these claim features. Furthermore, Herz, relied on upon for its alleged disclosure of a microprocessor and a memory that processes algorithms necessary to produce the user’s list (see Office Action, page 23 (citing Herz, column 51 lines 26-34 and FIG. 11)) fails to remedy the deficiency of Smolen. Therefore, for at least the reasons above, the Section 103 rejection of claim 51 should be withdrawn. Claims 52-61 depend from claim 51 and, therefore, are allowable for at least the reasons discussed above and in view of their additional recitations of novelty.

Conclusion

The application has been amended to place the application in better condition prior to examination. All amendments are supported by the specification. An early notice of allowance is earnestly solicited.

Please charge any shortage in the fees or credit any overpayment to Deposit Account No. 50-3266.

Respectfully submitted,
DLA PIPER US LLP



Dale S. Lazar
Registration No. 28,872
Attorney for Applicant

DSL/VKM/bel
PO Box 9271
Reston, VA 20195
(703) 773.4149 Telephone
(703) 773.5200 Fax

Attachment: Terminal Disclaimer